



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/525,896

10/17/2005

Marcus Plummer

UDL-101-US

9659

7590

08/27/2008

David Lesht
Cook Alex McFarron Manzo Cummings & Mehler
Suite 2850
200 West Adams Street
Chicago, IL 60606

EXAMINER

PAINTER, BRANON C

ART UNIT

PAPER NUMBER

3633

MAIL DATE

DELIVERY MODE

08/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/525,896	Applicant(s) PLUMMER, MARCUS	
	Examiner BRANON C. PAINTER	Art Unit 3633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 10 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 10 were added to claim 6, from which claim 10 depends.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

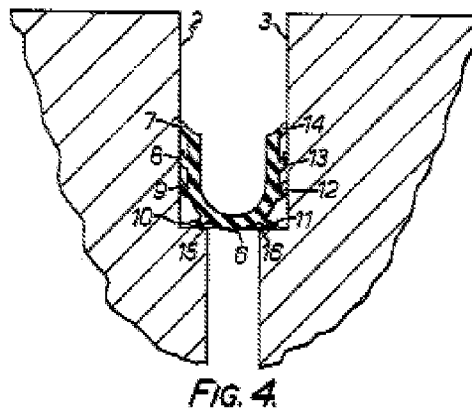
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 6, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Halls (GB 1,380,395).
4. Regarding claim 6, Halls discloses two adjacent panels with sealing strip having all of the applicant's claimed structure, including:
 - a. A sealing strip filling a gap between the panels ("sealing strip" 1 between "surfaces" 2, 3, Fig. 1, 4).
 - b. The sealing strip formed of a resiliently flexible material ("sealing strip 1, which is made of a resiliently flexible material such as a polymer or a material including a polymer," lines 87-90). The examiner notes that plastics

Art Unit: 3633

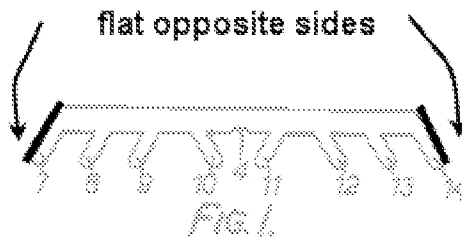
necessarily include polymers, therefore they are covered by the disclosure of Halls.

- c. The strip comprising a pre-formed line of weakness extending longitudinally along its length intermediate its opposite side edges ("notch" 4, Fig. 1).
- d. The strip being flat on opposite sides of the line in its as-formed condition (amended Fig. 1).
- e. The strip side edges being biased against the side edges of the respective adjacent panels with the strip inserted completely into the gap between panels ("the strip is resiliently deformable to a generally U-shape with the one face outermost by bending about the central longitudinal axis of the strip and to be positioned in a gap between juxtaposed surfaces," lines 28-33; Fig. 4).



Reproduced from Halls

Art Unit: 3633



Reproduced from Halls (amended)

5. Regarding claim 10, Halls discloses a flat strip with a line of weakness along which the strip is folded ("notch" 4, Fig. 1).
6. Regarding claim 1, Hall discloses the claimed method steps set forth in claim 1. Said steps can clearly be seen in Hall's specification and drawings.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 3-4 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halls (GB 1,380,395).

Art Unit: 3633

10. Regarding claim 8:

- a. Halls discloses two adjacent panels with sealing strip as set forth above.
- b. Halls does not expressly disclose that the strip is transparent.
- c. The examiner notes that it would have been an obvious matter of design choice to modify the strip by making it transparent, since applicant has not disclosed that transparent strips solve any stated problem or is for any particular purpose and it appears that a strip of any color would perform equally well in sealing the gap between floorboards.
- d. The examiner notes that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) {see MPEP 2144.04}.

11. Regarding claim 9:

- a. Halls discloses two adjacent panels with sealing strip as set forth above.
- b. Halls does not expressly disclose that the strip is V-shaped in cross-section.
- c. The examiner notes that it would have been an obvious matter of design choice to modify the U-shaped strip of Halls by making it V-shaped, since applicant has not disclosed that a V-shaped strip solves any stated problem or is for any particular purpose and it appears that a U-shaped strip would perform equally well in sealing the gap between floorboards.

Art Unit: 3633

- d. There is no invention in merely changing the shape or form of an article without changing its function except in a design patent. *Eskimo Pie Corp. v. Levous et al.*, 3 USPQ 23.
12. Regarding claims 3-4, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.
13. Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halls (GB 1,380,395) in view of Bogle (EP 0,940,524 A2 – Derwent Abstract).
14. Regarding claim 7:
- a. Halls discloses two adjacent panels with sealing strip as set forth above.
 - b. Halls does not expressly disclose a strip whose color closely resembles the color of the panel members.
 - c. Bogle discloses a strip colored to resemble the panel members (“The joint closure (10)...can be in a color matching the cladding boards,” Derwent Abstract; Fig. 5).
 - d. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the strip of Halls by coloring the strip so as to match the panels as taught by Bogle, in order to provide a more aesthetically pleasing panel joint.
 - e. The examiner notes that it would have been an obvious matter of design choice to modify the strip by making it similarly colored to the panels, since applicant has not disclosed that this specific strip coloring solves any stated

Art Unit: 3633

problem or is for any particular purpose and it appears that a strip of any color would perform equally well in sealing the gap between floorboards.

- f. The examiner notes that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) {see MPEP 2144.04}.

- 15. Regarding claim 2, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

Response to Arguments

- 16. Applicant's arguments filed 06/19/08 have been fully considered but they are not persuasive.
- 17. Applicant argues that the strip of Halls is not flat and does not have a pre-formed line of weakness. However, the strip of Halls is "flat on opposite sides of said line" as discussed above and shown in amended Fig. 1. Furthermore, the elongated notch 4 of Halls is a line of weakness and thus meets the claim limitations.
- 18. Applicant's arguments with respect to Bogle have been considered but are moot in view of the new ground(s) of rejection.
- 19. Applicant's arguments regarding floor board gap widths do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the

Art Unit: 3633

references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
21. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

Art Unit: 3633

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./

Examiner, Art Unit 3633

08/24/08

/Basil Katcheves/

Primary Examiner, Art Unit 3635